

REMARKS

In the Office Action of October 25, 2004, the Examiner rejected claim 19 under § 112, second paragraph asserting that “the other block” did not have sufficient antecedent basis. Applicant has rewritten claim 18 to define a first and second block to address this rejection without affecting the scope of protection provided by this claim.

The Examiner rejected claims 12, 15 and 17 under § 102(b) as being anticipated by Freiwald (DE3425641 A1). Claims 17 and 18 were rejected under § 102(b) as being anticipated by Kortmann (DE29502331 U1). Claims 1-16 and 19-20 were rejected under § 103(a) as being unpatentable over Kortmann in view of Barton (US3528668).

Freiwald, Kortmann and Barton teach three separate and distinct methods and apparatus for sealing a space between a hole and the outer surface of a pipe extending through the hole, none of those methods or apparatus being so similar to the presently claimed methods and apparatus so as to render any of those claims anticipated. Further, the methods and apparatus taught in these three references are so separate and distinct from one another, and their approaches to the various problems they were trying to solve so different, as to defeat a proposed combination of the teachings of the references in an attempt to assert that the presently claimed invention is obvious.

Freiwald teaches to use a plurality of individual foam blocks of differing shapes and sizes to substantially fill an annular space between a hole and an eccentrically positioned pipe in the hole. The upper pieces 1 are held in place by fasteners 5 and the lower pieces are built up on the overlapping wedge shaped pieces 3 and triangular pieces 4, and they are all pressed into the walls of the pipe and hole by insertion of triangular wedge pieces 2 providing a circumferential pressing force. There is no axial compression of the pieces, causing them to expand radially and circumferentially, nor are the individual pieces held together or fastened to one another.

Independent claim 12 defines connecting members engageable with each block to connect said blocks to each other to form a ring. No such connecting members are taught or suggested by Freiwald, and to use such members would destroy the teachings of Friewald which is to use lastly inserted triangular wedge pieces to hold all of the remaining pieces in place.

Independent claim 17 defines the block used in the seal member as having an aperture therein to receive a connecting member arranged to connect two adjacent blocks together. Again, no connecting members are provided or suggested by Freiwald, nor are any apertures provided in the Freiwald blocks for receiving any such connecting members.

For at least these reasons, Freiwald fails to anticipate independent claims 12 and 17, and dependent claim 15.

Kortmann discloses the use of a nesting of two or more fully annular rings each having a circular circumference and a circular hole therethrough, wherein the circular hole is positioned eccentrically relative to the circumference of each ring. An outer circumference of a nested ring is substantially the same size as a circumference of the circular hole of its surrounding ring. By rotating the nested rings relative to each other, the innermost circular hole can be moved through a wide range of eccentric positions relative to the outer circumference of the outer ring. Each "block" of Kortmann extends through a full 360 degrees to completely surround the pipe, and therefore must be inserted onto the pipe from an end of the pipe. In order to replace the sealing ring in an installed pipeline, it would be necessary to disassemble the pipeline to allow the sealing ring to be inserted over an open end of the pipe.

Independent claim 17 defines a width of each block to extend in a circumferential direction and further that the width of each block extend less than a full circumference of the pipe. As mentioned above, Kortmann specifically requires each block to extend the entire full circumference of the pipe in order to work. Because of this, Kortmann cannot anticipate claim 17 or its dependent claim 18.

Claim 17 further defines each block as having an aperture therein to receive a connecting member arranged to connect two adjacent blocks together. No connecting members are provided or suggested by Kortmann, nor are any apertures provided in the Kortmann blocks for receiving any such connecting members. In fact, in order to operate as Kortmann teaches, the two or more nested blocks are required to be able to rotate relative to one another in order to select the correct amount of eccentricity between the inner hole and the outer circumference, so attaching two adjacent blocks together would defeat the operability of the Kortmann device. For this additional reason, Kortmann cannot anticipate claim 17 or its dependent claim 18.

Independent claims 1, 7 and 20 were rejected over a combination of Kortmann and Barton. First, applicant submits that it is improper to combine the teachings of Kortmann and Barton as the Examiner has done. Barton merely discloses the standard modular type seal as discussed at page 1 of applicant's Specification. These modular seals are useful in sealing annular spaces between a pipe and a hole in a wall through which the pipe passes, but only when the pipe and the hole are substantially concentric. There is no recognition of the problem posed by eccentrically positioned pipes in Barton, and therefore, no reason or suggestion in Barton to combine its teachings with those of Kortmann. Kortmann on the other hand does address the problem of sealing an eccentric annular space, in a relatively simple and straight forward manner with two or more concentrically arranged rings which rotate relative to one another to achieve the necessary eccentricity. The motivation to combine any teachings of Barton with those of Kortmann come only from a hindsight reconstruction of applicant's claims, and not from any suggestion of either Kortmann or Barton, or recognition of the problems addressed by applicant's invention by either Barton or Kortmann.

Second, Kortmann does not incorporate all of the claimed elements of claims 1, 7 and 20 as ascribed by the Examiner. Specifically, claims 1, 7 and 20 define the width direction of the block as circumferential, and define that the width of each block extend less than a full circumference of the pipe. Contrarily, each block of Kortmann has a width which extends the full circumference of the pipe.

Claims 1, 7 and 20 further define the step of inserting or structure of a smallest thickness block (already defined as having a width less than a full circumference of the pipe) in a portion of the annular space between the pipe and the opening comprising a smallest radial dimension. Kortmann places each block in a position to surround the entire pipe, and not limited to a smallest radial dimension area of the opening. Similarly, claims 1, 7 and 20 define the step of inserting or structure of a largest thickness block in a portion of the annular space comprising a greatest radial dimension. Again, Kortmann surrounds the entire pipe with each block.

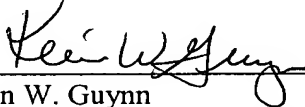
Claims 1, 7 and 20 define the step of inserting or structure of a bolt through the height of each block parallel to the axis of the pipe. Kortmann illustrates bolt openings as extending through only one of the two nested block rings. This is necessary in order to allow the Kortmann apparatus to function as described, that is, in order to allow the Kortmann rings to rotate relative to one another. There is no teaching or suggestion that Kortmann be modified,

such as by the completely different structure taught by Barton, to meet this requirement of claims 1, 7 and 20 , since such a structure is not necessary for a proper operation of the Kortmann apparatus.

For at least each of these reasons, it is respectfully submitted that claims 1, 7 and 20 and their dependent claims are patentably distinguishable over the references cited and applied by the Examiner singly and, where permissible, in combination.

In view of the foregoing, applicants respectfully submit that each of the independent claims of the application, and therefore also the dependent claims, are patentably distinguishable from the primary references and any permissible combination of primary and secondary references, and therefore request the Examiner to reconsider the rejections, indicate all claims as allowable and pass the application to issuance.

Respectfully submitted,

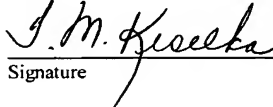


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